

## **REMARKS:**

Claims 1-31 are currently pending in the application. Claims 1-31 stand rejected under 35 U.S.C. § 103(a) over U.S. Patent No. 6,128,759 to Hansen ("Hansen") in view of U.S. Patent No. 6,510,420 B1 to Cessna et al. ("Cessna") in further view of U.S. Patent No. 6,360,332 B1 to Weinberg et al. ("Weinberg").

## **SPECIFICATION OBJECTION:**

The Examiner objects to the specification as containing informalities, specifically the phrase "are hampers" on page 13, lines 15-17. The Applicants have amended the specification as suggested by the Examiner. Thus, the Applicants respectfully request that the objection be reconsidered.

## **REJECTION UNDER 35 U.S.C. § 103(a):**

Claims 1-31 stand rejected under 35 U.S.C. § 103(a) over Hansen in view of Cessna and in further view of Weinberg. The Applicants respectfully submit that Hansen, Cessna, or Weinberg either individually or in combination, fail to disclose, teach, or suggest each and every element of claims 1-31. Thus, the Applicants respectfully traverse the Examiners obvious rejection of claims 1-31 under 35 U.S.C. § 103(a) over the proposed combination of Hansen, Cessna, and Weinberg either individually or in combination.

For example, with respect to independent claim 1, this claim recites:

1. A method for selecting members in a hierarchy, comprising:  
determining a sequence of one or more actions associated with a member selection tree, the actions collectively selecting one or more members from a hierarchy of members, the hierarchy of members being associated with a particular dimension of an organization of data;  
recording the sequence of actions in a member selection script; and  
executing the member selection script to select one or more members after the hierarchy of members has been modified. (Emphasis Added).

Independent claims 12 and 22 recite similar limitations. Hansen, Cessna, and Weinberg either individually or in combination, fail to disclose each and every limitation of independent claims 1, 12, and 22.

For example, the Examiner asserted Hansen discloses determining a sequence of one or more actions associated with a member selection tree, the actions collectively selecting one or more members from a hierarchy of members. Although Hansen discloses actions associated with a hierarchical tree of nodes (Abstract), Hansen does not disclose determining a sequence of actions that collectively select one or more members from a hierarchy of members. The only “actions” in Hansen associated with a tree structure are the testing actions involved in a testing sequence. These “actions” merely select the end leaves that correspond with a testing program. (Abstract). Hansen does not collectively select one or more members from a hierarchy of members, trees, or even the end leaves in a testing program.

The Applicants further submit that Hansen does not disclose executing the member selection script to select one or more members after the hierarchy of members has been modified. As mentioned above, Hansen does not disclose collectively selecting one or more members from a hierarchy of members. Thus, Hansen cannot execute a member selection script of a modified hierarchy of members since Hansen does not even collectively select a member from a hierarchy of members in the first place.

The Applicants further submit that the Office Action acknowledges that Hansen fails to disclose the emphasized limitations noted above in claim 1. Specifically the Examiner acknowledges that Hansen fails to disclose the hierarchy of members being associated with a particular dimension of an organization of data. However, the Examiner asserts that the cited portions of Cessna disclose the acknowledged shortcomings in Hansen. The Applicants respectfully traverse the Examiners assertions regarding the subject matter disclosed in Cessna.

The Applicants respectfully submit that Cessna has nothing to do with the claim 1 limitations regarding determining a sequence of actions that collectively select one or more members from a hierarchy of members associated with a particular dimension of an

organization of data. Rather, Cessna describes an approach a planner may use to view data at a predetermined granularity. (column 1, lines 33-42). This approach merely allows a planner to view data at different levels within a hierarchy. Cessna fails to disclose the sequence of actions associated with a particular dimension of an organization of data.

The Applicants further submit that the Office Action acknowledges that both Hansen and Cessna, either individually or in combination, further fail to disclose the limitations of claim 1. Specifically the Examiner acknowledges that both Hansen and Cessna fail to disclose recording the sequence of actions in a member selection script. However, the Examiner asserts that Weinberg discloses the acknowledged shortcomings in Hansen and Cessna. The Applicants respectfully traverse the Examiners assertions regarding the subject matter disclosed in Weinberg.

The Applicants respectfully submit that Weinberg fails to disclose the limitations recited in claim 1 regarding recording the sequence of actions in a member selection script. Rather, Weinberg describes a testing tool for testing the functionality of a transactional server where a series of user steps are recorded. (Figure 6A-6C). The testing tool merely displays these recorded user steps to allow for verification of expected server responses. Weinberg fails to disclose recording the sequence of actions, associated with a member selection tree, in selecting at least one member from a hierarchy of members associated with a particular dimension of an organization of data, into a member selection script.

The Applicants respectfully submit that the Office Action has failed to properly establish a *prima facie* case of obviousness. The Office Action merely states that portions of the claimed invention would have been a highly desirable feature in this art. A recent Federal Circuit case makes it crystal clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. In re Lee, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at

1434-35. Thus, the Office Action fails to provide proper motivation for combining the teachings of Hansen, Cessna, or Weinberg, either individually or in combination.

Claim 1 is considered patentably distinguishable over the proposed combination of Hansen, Cessna, and Weinberg for at least the reasons discussed above in connection with claim 1. With respect to independent claims 12 and 22 each of these claims includes limitations similar to those discussed above in connection with claim 1. Thus, claims 12 and 22 are considered patentably distinguishable over the proposed combination of Hansen, Cessna, and Weinberg for at least the reasons discussed above in connection with claim 1.

With respect to dependent claims 2-11, 13-21, and 23-31, claims 2-11 depend from independent claim 1, claims 13-21 depend from independent claim 12, and claims 23-31 depend from independent claim 22. As mentioned above, each of independent claims 1, 12, and 22 are considered patentably distinguishable over the proposed combination of Hansen, Cessna, and Weinberg. Thus, dependent claims 2-11, 13-21, and 23-31 are considered to be in condition for allowance for at least the reason of depending from an allowable claim.

For the reasons set forth herein, the Applicant submits that claims 1-31 are not rendered obvious by the proposed combination of Hansen, Cessna, and Weinberg. The Applicant further submits that claims 1-31 are in condition for allowance. Thus, the Applicant respectfully requests that the rejection of claims 1-31 under 35 U.S.C. § 103(a) be reconsidered and that claims 1-31 be allowed.

#### **THE LEGAL STANDARD FOR OBVIOUSNESS REJECTIONS UNDER 35 U.S.C. § 103:**

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the

claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); M.P.E.P. § 2142. Moreover, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (CCPA 1974). If an independent claim is nonobvious under 35 U.S.C. § 103, then any claim depending therefrom is nonobvious. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988); M.P.E.P. § 2143.03.

With respect to alleged obviousness, there must be something in the prior art as a whole to suggest the desirability, and thus the obviousness, of making the combination. *Panduit Corp. v. Dennison Mfg. Co.*, 810 F.2d 1561 (Fed. Cir. 1986). In fact, the absence of a suggestion to combine is dispositive in an obviousness determination. *Gambro Lundia AB v. Baxter Healthcare Corp.*, 110 F.3d 1573 (Fed. Cir. 1997). The mere fact that the prior art can be combined or modified does not make the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 U.S.P.Q.2d 1430 (Fed. Cir. 1990); M.P.E.P. § 2143.01. The consistent criterion for determining obviousness is whether the prior art would have suggested to one of ordinary skill in the art that the process should be carried out and would have a reasonable likelihood of success, viewed in the light of the prior art. Both the suggestion and the expectation of success must be founded in the prior art, not in the Applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991); *In re O'Farrell*, 853 F.2d 894 (Fed. Cir. 1988); M.P.E.P. § 2142.

A recent Federal Circuit case makes it clear that, in an obviousness situation, the prior art must disclose each and every element of the claimed invention, and that any motivation to combine or modify the prior art must be based upon a suggestion in the prior art. *In re Lee*, 61 U.S.P.Q.2d 1430 (Fed. Cir. 2002). Conclusory statements regarding common knowledge and common sense are insufficient to support a finding of obviousness. *Id.* at 1434-35.

**CONCLUSION:**

In view of the foregoing amendments and remarks, this application is considered to be in condition for allowance, and early reconsideration and a Notice of Allowance are earnestly solicited.


A Request for Extension for Response Within the First Month is being filed concurrently herewith along with a Transmittal letter that includes an authorization to charge the Extension of Time fee of \$120.00 to Deposit Account No. **500777**. If there is no separate Petition for Extension of Time filed herewith, this document is to be construed as also constituting a Petition for Extension of Time Under 37 C.F.R. § 1.136(a) for a period of time sufficient to enable this document to be timely filed. Any fee required for such Petition for Extension of Time should be charged to Deposit Account No. **500777**.

**Please link this application to Customer No. 38441 so that its status may be checked via the PAIR System.**

Respectfully submitted,

2 MAY 2005

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